The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 30

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte AKIRA SUGIYAMA

Appeal No. 2003-2050
Application No. 09/194,051

ON BRIEF[1]

Before HAIRSTON, RUGGIERO, and BLANKENSHIP, Administrative Patent Judges.

BLANKENSHIP, Administrative Patent Judge.

REMAND TO EXAMINER

This is a remand of the appeal under 35 U.S.C. § 134 from the final rejection of claims 1-39, in accordance with 37 CFR § 1.196(a), (e). After considering the record before us, we are convinced that the instant appeal is not ready for meaningful review. Accordingly, we hereby remand the application to the examiner to consider the following issues, and to take appropriate action.

[1] Appellant waived an oral hearing via facsimile communication filed December 15, 2003.

REASONS FOR REMAND

The Examiner's Answer, at pages 3 and 4, contends that at least claims 4, 10, and 16-19 are rejected under 35 U.S.C. § 112, second paragraph. The same Answer, at page 9, indicates that the section 112 rejection of the claims has been withdrawn.

We infer that the section 112 rejection set forth in the Final Rejection has been withdrawn. The remaining ground of rejection is that against claims 1-39 under the judicially created doctrine of obviousness-type double patenting over claims 1-7 of U.S. Patent 5,933,625 in view of U.S. Patent 5,502,765.

Independent claims 1 and 5 of the '625 patent contain elements in means plus function format, as permitted under 35 U.S.C. § 112, sixth paragraph. The scope of the claimed elements are thus limited to the corresponding structures in the disclosure and their equivalents. All the independent claims of the instant application also contain elements in means plus function format, which are thus limited in scope to the corresponding structures in the disclosure and their equivalents. The limitations under 35 U.S.C. § 112, sixth paragraph must be interpreted by reference to the corresponding disclosure. See, e.g., In re Lonardo, 119 F.3d 960, 967, 43 USPQ2d 1262, 1267 (Fed. Cir. 1997) (citing In re Donaldson Co., 16 F.3d 1189, 1193, 29 USPQ2d 1845, 1849 (Fed. Cir.1994) (in banc)).

If the obviousness-type double patenting rejection is to be maintained, the examiner must provide a supplemental Answer that sets forth how one claim of the instant application is to be interpreted, with reference to the specification when

appropriate, and how one (or more) conflicting claim(s) of the patent is to be interpreted, with reference to the patent's disclosure when appropriate. Any supplemental Answer must also set forth a comparison between each requirement of the selected one application claim with the requirements of one (or more) conflicting patent claim. The examiner must set forth specific findings with respect to the differences between the inventions defined by the conflicting claims, and the reasons why the artisan would conclude that the invention defined in the application claim is an obvious variation of the invention defined in the claim(s) in the patent.

We stress that the analysis should be limited to one application claim with respect to one (or more) conflicting patent claim(s).[2] Many of the issues and controversies in the instant appeal appear to be irrelevant in view of the apparent subject matter of the broadest claims in the instant application and the broadest claims in the patent.

The examiner is thus permitted to submit a supplemental Answer under 37 CFR § 1.193(b)(1). Under the current rules, an Answer cannot contain any new grounds of rejection. 37 CFR § 1.193(a)(2). We note, however, that certain claims of the instant application are in improper dependent form.

Instant claim 11 purports "[a] recording media [sic] having stored thereon unique authentication data created by any one of said subservient computers as recited in

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[2] If the examiner deems it necessary, a second application claim may be selected for a separate analysis with respect to one (or more) conflicting patent claim(s).

claim 1...." Claim 11, although in dependent form, fails to further limit the subject matter of claim 1.[3] Similarly, instant claims 27, 29, 30, and 31 fail to further limit the claim from which each depends. The claims thus should be rejected under 35 U.S.C. § 112, fourth paragraph, as failing to further limit the subject matter of the claims from which they depend.

CONCLUSION

The instant application is remanded to the examiner to consider the aforementioned issues and to take action accordingly.

If the examiner wishes to maintain the obviousness-type double patenting rejection, then the examiner is permitted to submit a supplemental Answer under 37 CFR § 1.193(b)(1). Appellant may file a reply brief to a supplemental Answer within two months from the date of such supplemental answer. 37 CFR § 1.193(b)(1).

[3] Claim 1 is drawn to "[a]n authentication-data issuing system," having "transmitter means" with functions relating to a master computer and a subservient computer.

This application, by virtue of its "special" status requires an immediate action. MPEP § 708.01. It is important that the Board be informed promptly of any action affecting the status of the appeal.

REMANDED

KENNETH W. HAIRSTON
Administrative Patent Judge

JOSEPH F. RUGGIERO
Administrative Patent Judge

HOWARD B. BLANKENSHIP
Administrative Patent Judge

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